



Docket No.: 21776-00034-US  
(PATENT)

#18) Reply  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Conf. No. 9109

Hiroaki Kimura, et al.

Application No.: 09/241,735

Group Art Unit: 2123

Filed: February 2, 1999

Examiner: F. Ferris

For: APPARATUS FOR ANALYZING SOFTWARE  
AND METHOD OF THE SAME

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**APPELLANTS REPLY BRIEF FILED UNDER 37 C.F.R. § 1.193(B)**

**Mail Stop Appeal Brief - Patents**

**Due Date: August 4, 2003**

Commissioner for Patents

Attn: Board of Patent Appeals and Interferences

Washington, DC 20231

Dear Sir:

This Reply Brief is in furtherance of the Notice of Appeal, filed in this case on August 8, 2002, the Substitute Appellants' Brief filed March 12, 2003, and the Examiner's Answer mailed on June 4, 2003.

The required fees are authorized to be charged to CBLH Deposit Account No. 22-0185, as indicated in the accompanying Fee Transmittal.

This brief is transmitted in triplicate.

**PURPOSE OF REPLY BRIEF**

The purpose of this Reply Brief is to respond to what appears to be new points of argument raised in the Examiner's Answer, and to respond to apparent mischaracterizations or misunderstanding by the Examiner of Appellants' previously submitted arguments.

Appellants are not in disagreement with paragraphs (1) - (4), (8), and (9) of the Examiner's Answer.

The specific issues that are addressed in this Reply Brief relate to Appellants' disagreement with paragraphs (5) - (7) and (10) - (11) of the Examiner's Answer.

These related issues are summarized below:

**ISSUES ADDRESSED IN REPLY BRIEF**

- I. **THE SUMMARY OF INVENTION SECTION IS IN ACCORD WITH THE SUGGESTIONS OF THE MPEP**
- II. **ARGUMENTS RELATING TO OBJECTIONS TO THE SPECIFICATION MAY BE CONSIDERED ON APPEAL OF 35 U.S.C. §112, FIRST PARAGRAPH REJECTIONS**
- III. **ARGUMENTS RELATING TO DISTINCTIONS OVER THE APPLIED ART WERE PREVIOUSLY PROVIDED WITH SPECIFIC REFERENCE TO THE CLAIMED INVENTION**
- IV. **THE CLAIMS DO NOT STAND OR FALL TOGETHER**
- V. **PROCESS TERMS SUCH AS METRICS INFORMATION, REDUNDANCY INFORMATION, AND MAINTENANCE DOCUMENT INFORMATION, EVEN ASSUMING THAT THEY DO NOT HAVE A SPECIFIC MEANING IN THE ART, ARE SUFFICIENTLY DEFINED BY THE SPECIFICATION**
- VI. **ADMITTED CONVENTIONAL ASPECTS OF THE CLAIMED INVENTION NEED NOT BE DETAILED IN THE SPECIFICATION**
- VII. **THE EXPLICIT STATEMENT OF THE FINAL REJECTION FOR LACK OF ENABLEMENT LACKS THE SPECIFICITY REQUIRED BY §§706.03(C) AND 707.07(D) OF THE MPEP**
- VIII. **THE ANTICIPATION REJECTION DOES NOT IDENTIFY, WITH SPECIFICITY, THAT EACH RECITED LIMITATION OF THE CLAIMS ON APPEAL ARE FOUND IN THE REFERENCE**
- IX. **THE EXAMINER NOW APPEARS TO IMPROPERLY INVOKE "ANTICIPATION BY INHERENCY" CONCERNING FEATURES ASSERTED IN THE FINAL REJECTION AS BEING "WELL-KNOWN"**

## RESPONSE

### I. THE SUMMARY OF INVENTION SECTION IS IN ACCORD WITH THE SUGGESTIONS OF THE MPEP

The invention defined at least by the independent claims on appeal are concisely explained with reference to page and line numbers of the Specification and the Drawings, as *suggested* by the MPEP.

“This explanation is required to refer to the specification by page and line number, and, if there is a drawing, to the drawing by reference characters. *Where applicable, it is preferable to read the appealed claims on the specification and any drawing.* While reference to page and line number of the specification may require somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application.”<sup>1</sup>

One example of the concise summary provided in Appellants’ Brief (*with emphasis added*) is quoted below with respect to claim 1 (Group I):

“In one embodiment of the invention claimed in independent claim 1 (Group I), a software analysis apparatus includes program analysis information generation means for automatically generating program analysis information required for analyzing a computer program (*See Specification at p. 5, lines 9-12, p. 7, line 24, through p. 8 line 5, and original claim 1, lines 2-4*); program analysis information storage means (*See Specification at p. 5, lines 12-15, and p. 8, line 6*) for classifying the program analysis information generated by said program analysis information generation means in an arbitrary unit or at an arbitrary timing (*See Specification at p. 16, lines 17-22, e.g., classified in accordance with Fig. 2, in an exemplary embodiment, as a particular type of data*), and sequentially storing the program analysis information in a predetermined data recording medium (*See Specification at p. 5, lines 13-17, p. 8, lines 6-18, and original claim 1, lines 5-9*); and program analysis means for executing program analysis by reading out the program analysis information from the data recording medium (*See Specification at p. 5, lines 17-20, p. 8, lines 20-24, p. 18, line 14 through p. 22, line 28, and original claim 1, lines 11-13*). In addition, *see Figs. 1, 3, and 4 of the Drawings.*”<sup>2</sup>

Similar concise summary, with reference to the Specification page/line numbers and the Drawings, is provided for the remaining independent claims in Groups II and III. In addition, separately grouped dependent claims 7, 18, and 29 (Group IV), depending from independent

<sup>1</sup> See MPEP (8th ed., rev. 1) §1206, p. 1200-10 (emphasis added).

<sup>2</sup> See Appellants’ Brief, at page 5, lines 2-15, §V(B), “Disclosure Relating to the Claimed Embodiments”.

claims 1, 13, and 24, respectively, and independent claims 11, 22, and 33, also in Group IV, have been summarized in the above-noted fashion.

This approach was suggested for conciseness and brevity of the Appeal Brief by Supervisory Examiner Teska during the telephonic interview with the undersigned attorney on February 26, 2003, and was adopted in good faith by the undersigned in submitting the Substitute Appellants' Brief.

Further, all sections of Appellants' Brief *required* by the MPEP are present in the Substitute Appellants' Brief.

In addition to all of the required sections, Appellants have submitted an optional "plain language" overview (see §V(A) on p. 3 of the Substitute Appellants' Brief), and an optional Appendix B to the Brief to provide a more detailed background discussion of conventionally-available software analysis information (paraphrasing, quoting, and/or derived from Appellants' Specification), in an effort to provide context for the invention and to allow a better appreciation of the claims on appeal by the Honorable Board. These optional sections were not included, as the Examiner asserts, to present "arguments" relating to conventional techniques, present advantages of the claimed invention, or to "cure" any purported §112(1) deficiencies.

Finally, it is not at all clear to the undersigned that "arguments" are being presented in the Summary of Invention section, at page 3, lines 10-20, as asserted by the Examiner at page 4, paragraph (6) of the Examiner's Answer. This passage cited by the Examiner is quoted below from Appellants' Brief:

"To set the stage for this appeal, and in light of the Examiner's comments and apparent misunderstanding of the novel and non-obvious aspects of the claimed invention, and to place the claims on appeal in their proper context for the Honorable Board, a background discussion of conventionally-available software analysis information is submitted as Appendix B to this Brief, in an effort to enable a better appreciation of the claims on appeal.

As a further preliminary matter, Appellants note that the claims, as originally filed, may be relied upon to provide supporting disclosure, as the claims as filed in the original Specification are part of the disclosure" (footnote omitted).<sup>3</sup>

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<sup>3</sup> See Substitute Appellants' Brief at p. 3, lines 10-20.

Appellants submit that the entirety of the “Summary of Invention” section of the Substitute Appellants’ Brief is proper, and should be considered by the Honorable Board, along with the optionally presented Appendix B.

## **II. ARGUMENTS RELATING TO OBJECTIONS TO THE SPECIFICATION MAY BE CONSIDERED ON APPEAL OF 35 U.S.C. §112, FIRST PARAGRAPH REJECTIONS**

Although Appellants believe that specific arguments directed solely against the objections to the Specification were removed from the Substitute Appellants’ Brief, if any such argument against the *objection* to the Specification remains in the Substitute Appellants’ Brief, Appellants respectfully request such arguments be given consideration by the Board for the reasons set forth in the Substitute Appellants’ Brief, and as reiterated below.

The Examiner’s §112, first paragraph rejection is completely intertwined with the objection to the Specification. “Claims 1-37 are rejected under 35 U.S.C. §112, first paragraph, for the reasons set forth in the objections to the specification.”<sup>4</sup>

For the Examiner to take the position of not allowing any mention of the believed impropriety of the objection to the Specification within the context of arguments against §112(1) rejections is submitted as being untenable and unfair to Appellants.

In fact, and although it is true that objections are typically not appealable, and are usually only addressable by Petition to the Commissioner, as this Honorable Board of Patent Appeals and Interferences has held, “[t]hat part of the Examiner’s ‘objection’ which centers on description, enablement and best mode concerns the correspondence of the specification to the statutory requirements set forth in 35 U.S.C. §112 and is within the jurisdiction of the BPAI.”<sup>5</sup>

Accordingly, Appellants suggest that the Examiner’s refusal to address arguments against the objection to the Specification, if indeed such arguments are present, and insofar as they are intertwined with and relate to the §112(1) rejections, is improper and ignores the previous holding of this Honorable Board.

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<sup>4</sup> See Final Official Action at p. 3, paragraph 4.

<sup>5</sup> *Ex parte C*, 27 USPQ 2d 1492 (B.P.A.I. 1993).

Appellants respectfully request that the Honorable Board also consider any such arguments in the Substitute Appellants' Brief relating to the Examiner's objection to the Specification, as long as any such arguments are found within the context of arguments pertaining to the impropriety of the rejections under 35 U.S.C. §112, first paragraph.

### **III. ARGUMENTS RELATING TO DISTINCTIONS OVER THE APPLIED ART WERE PREVIOUSLY PROVIDED WITH SPECIFIC REFERENCE TO THE CLAIMED INVENTION**

The Examiner asserts that "...appellant's arguments regarding prior art have essentially only recited the prior art teaching followed by a recitation of the claims without pointing out the patentable distinction between the claimed invention and the prior art."<sup>6</sup> Appellants disagree with this characterization of the arguments against anticipation contained in the Substitute Appellants' Brief.

Appellants believed it to be apparent that those features identified and specifically set forth in response to an anticipation rejection are being submitted as defining patentable distinctions over the applied art, particularly when the response indicates that recited features are not disclosed in the applied art.

To reiterate, as previously presented in the Substitute Appellants' Brief, Appellants offered the following specific distinctions of various ones of the claims on appeal over the applied art, Wygodny et al. (US 6,282,701), among other specific distinctions relating to various dependent claims (not listed in this Reply Brief):

"As for the specific deficiencies of the applied art with respect to the claimed invention, Wygodny et al. does not disclose a software analysis apparatus which includes, among other features, "...program analysis information generation means for automatically generating program analysis information required for analyzing a computer program; program analysis information storage means for classifying the program analysis information generated by said program analysis information generation means in an arbitrary unit or at an arbitrary timing, and sequentially storing the program analysis information in a predetermined data recording medium...", as recited in independent claim 1."<sup>7</sup>

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<sup>6</sup> See Examiner's Answer at p. 4, paragraph (6).

<sup>7</sup> See Substitute Appellants' Brief at p. 19, first full paragraph.

“Wygodny et al. does not disclose a software analysis apparatus for generating program analysis information required for analyzing a computer program, which includes, among other features, “...means for hierarchically registering the generated program analysis information in a database in units of analysis objectives; [and] means for implementing analysis of the hierarchically registered program analysis information by reading out the program analysis information already registered in a predetermined layer in correspondence with an analysis objective upon analyzing the computer program”, as recited in independent claim 11.”<sup>8</sup>

“Wygodny et al. does not disclose a software analysis method, which includes, among other features, “...classifying the program analysis information in an arbitrary unit or at an arbitrary timing; sequentially storing the program analysis information in a predetermined data recording medium; and executing program analysis by reading out the program analysis information from said data recording medium”, as recited in independent claim 13.”<sup>9</sup>

“Wygodny et al. does not disclose a software analysis method for generating program analysis information required for analyzing a computer program, which includes, among other features, “...hierarchically registering the generated program analysis information in a database in units of analysis objectives...”, as recited in independent claim 22.”<sup>10</sup>

“Wygodny et al. does not disclose a computer readable recording medium recording a computer program for making a computer implement, among other functions, “...a program analysis information classification function of classifying the program analysis information generated by the program analysis information generation function in an arbitrary unit or at an arbitrary timing; a program analysis information storage function of sequentially storing the classified program analysis information generated by the program analysis information classification function in a predetermined data recording medium; and a program analysis function of executing program analysis by reading out the classified program analysis information from said data recording medium”, as recited in independent claim 24.”<sup>11</sup>

“Finally, Wygodny et al. does not disclose a computer readable storage medium recording a program for making a computer implement, among other functions, “...hierarchically registering the generated program analysis information in a database in units of analysis objectives...”, as recited in independent claim 33.”<sup>12</sup>

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<sup>8</sup> See Substitute Appellants’ Brief at p. 22, second full paragraph.

<sup>9</sup> See Substitute Appellants’ Brief at p. 20, second full paragraph.

<sup>10</sup> See Substitute Appellants’ Brief at p. 23, second full paragraph.

<sup>11</sup> See Substitute Appellants’ Brief at p. 20, last paragraph, through p. 21, line 4.

<sup>12</sup> See Substitute Appellants’ Brief at p. 23, last paragraph.

Therefore, Appellants submit that, contrary to the Examiner's assertions, the previously presented arguments point out, with specificity, the patentable distinctions of the claims on appeal over the applied art.

#### **IV. THE CLAIMS DO NOT STAND OR FALL TOGETHER**

Although the undersigned apparently did not make the separate arguments for patentability of the claim groups I-IV sufficiently clear in the Substitute Appellants' Brief, the claims on appeal are reiterated as not standing or falling together. The claims are grouped as follows:

<u>Group</u>	<u>Claims</u>
I	1-6, 8-10, and 35
II	13-17, 19-21, and 36
III	24-28, 30-32, and 37
IV	7, 11, 12, 18, 22, 23, 29, 33, and 34

Appellants offer the following comments in this regard, to clarify the rationale for the stated claim groupings, and to clearly set forth the bases for separate grounds of patentability of the claims in each of claim groups I-IV, as detailed in the Substitute Appellants' Brief.

Appellants first point out that independent apparatus claim 1 (Group I), independent method claim 13 (Group II), and independent computer-readable medium claim 24 (Group III) are each of a different statutory class of invention, and are submitted as being separately patentable at least on that basis.

Further, these claims are submitted as being separately patentable in view of the various distinctions of the claimed invention in view of the shortcomings of the applied art, as discussed as Issues B through E in the Substitute Appellants' Brief. For example, independent claims 13 and 24 recite a classification function which is submitted as being absent in the disclosure of the applied art.

In addition, independent claims 11, 22, and 33 in Group IV are each directed to a different statutory class of invention, i.e., apparatus, method, and computer-readable medium, respectively, but which share one or more unique aspects, such as, for example, a feature relating



to use of a database, which the applied art does not disclose . Similarly, dependent claims 7, 12, 18, 23, 29, and 34, each of various statutory classes of invention, also share one or more unique aspects relating to use of a database or, by way of further distinction, as an object-oriented database in dependent claims 12, 23, and 34.

Accordingly, Appellants submit that separate arguments for patentability have been set forth with respect to each of the claim groups, such that the claims on appeal do not stand or fall together.

**V. PROCESS TERMS SUCH AS METRICS INFORMATION, REDUNDANCY INFORMATION, AND MAINTENANCE DOCUMENT INFORMATION, EVEN ASSUMING THAT THEY DO NOT HAVE A SPECIFIC MEANING IN THE ART, ARE SUFFICIENTLY DEFINED BY THE SPECIFICATION**

Appellants, in their Specification, have provided definitions of each of these terms, as discussed in APPENDIX B of the Substitute Appellants' Brief, and as repeated below with reference to the Specification.

For example, Appellants submit that "Metrics information" is known to be a measure of software quality which indicate the complexity, understandability, testability, description and intricacy of code, and which pertains to numeration indices of software. (See Specification, as previously amended, at p. 13, lines 15-27).

"Redundancy information" pertains to a redundant sentence that does not influence output in a single procedure. (See Specification, at p. 14, lines 1-8).

"Maintenance document information" refers to a document group used upon maintaining a program. (See Specification, at p. 14, lines 9-20).

Accordingly, Appellants submit that the terms above, which were mentioned by the Examiner as not having equivalent specific meaning in the art, are adequately defined by the instant Specification, particularly considering the knowledge of a person having skill in the art with respect to the known program analysis tools and techniques.

Therefore, Appellants submit that a person having skill in the art can fully understand and appreciate the novel and non-obvious features of the recited invention from the description

contained in the instant Specification.

**VI. ADMITTEDLY CONVENTIONAL ASPECTS OF THE CLAIMED INVENTION  
NEED NOT BE DETAILED IN THE SPECIFICATION**

To reiterate the previously submitted arguments, “[t]he burden of showing that the claimed invention is not described in the application rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not in *ipsis verbis* is insufficient.”<sup>13</sup>

Appellants again submit that, since each of these conventional processes used in various ways as precursor information for the inventive claimed apparatus and method are generally known, the instant specification is not required to discuss these processes in detail. “An applicant (patentee) may begin at a point where his invention begins and describe what he has made that is new, and what it replaces of the old. That which is common and well known is as if it were written out in the application (patent) and delineated in the drawings.”<sup>14</sup>

Further, “[u]nder 35 U.S.C. §112, a specification need not teach that which is obvious to those in the art.”<sup>15</sup> “A patent need not teach, and preferable omits, what is well known in the art.”<sup>16</sup> Finally, “[t]he disclosure of an application embraces not only what is expressly set forth in words and drawings, but what would be understood by persons skilled in the art. Those features that are well known are as if they were written out in the patent.”<sup>17</sup>

Notwithstanding the above-cited case law, the instant specification provides description of the conventional processes executed by the program analysis means, such as call graph and flow graph which are graphically displayed, influence range analysis, structure analysis and data flow anomaly analysis (See App. B of the Substitute Appellants’ Brief, and Specification at p. 9, line 20 through p. 14, line 20).

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<sup>13</sup> *In re Edwards, Rice, and Soulen*, 196 USPQ 465, 469 (C.C.P.A. 1978).

<sup>14</sup> *Webster Loom Co. v. Higgins*, 105 U.S. 580, 586 (1882).

<sup>15</sup> *In re Sureau, Kremer, and Dupre*, 153 USPQ 66, 70 (C.C.P.A. 1967).

<sup>16</sup> *Spectra-Physics Inc. v. Coherent Inc.*, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987).

<sup>17</sup> *Ex parte Wolters and Kuypers*, 214 USPQ 735 (PTO Bd. App. 1979).

**VII. THE EXPLICIT STATEMENT OF THE FINAL REJECTION FOR LACK OF ENABLEMENT LACKS THE SPECIFICITY REQUIRED BY §§706.03(C) AND 707.07(D) OF THE MPEP**

With respect to the rejections under 35 U.S.C. §112, first paragraph, the Examiner indicates in his Answer that “the previous office actions have clearly been directed to lack of enablement.”<sup>18</sup> Putting aside exactly what *previous* actions were directed to, Appellants point out that the explicit statement of the *final rejection* under §112(1) reads, in pertinent part, as follows:

“Claims 1-37 are rejected under 35 U.S.C. 112, first paragraph, for reasons set for the in the objections to the specification. No algorithms are given and no analytical process is described. The specification makes reference to the claimed invention analyzing a computer program, and automatically generating program analysis information but does not specifically explain the process...”<sup>19</sup>

As for the objection to the Specification, relied upon in the §112(1) rejection, the Examiner stated:

“The disclosure is objected to because of the following informalities...[t]he specification includes a reference to Japanese patent applications...as part of the claimed inventions description...[t]he incorporation of essential material in the specification by reference to a foreign application...is improper. Applicant is required to amend the disclosure to include the material incorporated by reference...[c]orrective action is required.”<sup>20</sup>

Appellants submit that the above explicit statement of the final rejection, along with the statement of the objection to the Specification, does not provide clarity as to the exact nature, i.e., written description or enablement, of the rejections. Appellants are accustomed to receiving explicit statements of the rejection using established PTO form paragraphs (e.g., PTO Form Paragraph 7.31.02), to ensure clarity and completeness of communication.

In the Response to Arguments section of the final Official Action, the Examiner indicated that “[t]he 112(1) rejection was given, and is upheld, by the Examiner because the specification does not contain a written description of the invention, and of the manner and process of making

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<sup>18</sup> See Examiner’s Answer at p. 6, paragraph (11).

<sup>19</sup> See Final Official Action at p. 3, paragraph 4.

<sup>20</sup> See Final Official Action at p. 2, paragraph 3.

and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the invention”<sup>21</sup> (emphasis in original).

As the final rejection did not provide great specificity or what is believed to be adequate particularity regarding the nature of the §112(1) rejection, Appellants thought it prudent to not assume the type of rejection under §112(1), particularly during appeal. Therefore, in the Substitute Appellants’ Brief, Appellants addressed the possibility of either a rejection for lack of enablement or for lack of written description.

The Examiner now indicates on the record in his Answer that the §112(1) rejection is for lack of enablement. Appellants previously submitted arguments against an enablement rejection are maintained and reiterated.

**VIII. THE ANTICIPATION REJECTION DOES NOT IDENTIFY, WITH SPECIFICITY, WHERE EACH RECITED LIMITATION OF THE CLAIMS ON APPEAL ARE FOUND IN THE REFERENCE**

The explicit statement of the anticipation rejection over Wygodny et al. reads as follows:

“Claims 1-37 are rejected under 35 U.S.C. §102(e) as being clearly anticipated by U.S. Patent No. 6,282,701, Wygodny et al. While the specification regarding the claimed invention is delinquent in the areas cited in paragraphs 3 and 4, the examiner makes prior art rejections based [upon] the following observations.”<sup>22</sup>

The subsequent observations provided by the Examiner with respect to independent claim 1 and dependent claims 2-10 amount only to a narrative discussion of Wygodny et al., without any specific or particular reference to any claim limitation in independent claim 1.

For example, in the discussion of the reference relating to claims 1-10, there is no mention of any disclosure of the recited “...program analysis information storage means for classifying the program analysis information generated by said program analysis information generation means...”, as recited in independent claim 1. Instead, the narrative discussion of the reference makes mention of and emphasizes the teaching of “trace data” relating to multiple processes.

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<sup>21</sup> See Final Official Action at p. 8.

<sup>22</sup> See Final Official Action at p. 4.

Appellants submit that similar deficiencies of the particularity of the anticipation rejections of the remaining claims on appeal exist and are apparent upon a reading of the claims onto the narrative discussion of the applied reference provided in the final rejection.

**IX. THE EXAMINER NOW APPEARS TO IMPROPERLY INVOKE  
“ANTICIPATION BY INHERENCY” CONCERNING FEATURES ASSERTED  
AS BEING “WELL-KNOWN”**

The Examiner, in response to arguments concerning the lack of disclosure of a database or database structure, now asserts that “...this [a database] is obviously an inherent feature to any software program analysis system, it is also expressly disclosed by Wygodny in Fig. 1 (121)”<sup>23</sup> (emphasis in original).

Appellants submit that there is a reasonable basis for questioning whether debug information 121 actually discloses a database, as now offered in the Examiner’s Answer.

“The debug information 121 is preferably created by a compiler when the client is compiled. Using the debug information 121 the analyzer translates function names and source lines to addresses when creating the TCI file 120. Conversely, the analyzer 106 uses the debug information 121 to translate addresses in the trace data back into function names and source lines when formatting a display for the user interface.”<sup>24</sup> It is not clear to the undersigned that this necessarily implies that debug information 121 is a database or that debug information 121 has a database structure.

Certainly, the applied art is silent on any mention of an object-oriented database, as recited in various ones of the dependent claims on appeal in Group IV.

In response to Appellants’ arguments against the propriety of asserting that certain features in the claims on appeal, although not disclosed in the reference, are “well-known”, the Examiner now appears to rely upon an uncertain standard of patentability referred to as “*obviously inherent*”<sup>25</sup>. Appellants and the undersigned are not familiar with this benchmark.

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<sup>23</sup> See Examiner’s Answer at p. 14, first paragraph.

<sup>24</sup> See Wygodny et al. at col. 8, lines 21-28.

<sup>25</sup> See Examiner’s Answer at p. 14, next to last paragraph.

Appellants point out that there is no evidence in the record to support these allegations of subject matter which is “obviously inherent” in any system used for analyzing software programs.

Appellants again reiterate that the rejections on appeal are for anticipation under 35 U.S.C. §102, and not for unpatentability under §103. There has been no indication of any art of record, which is properly combinable with Wygodny et al. in an unpatentability rejection, and which teaches or suggests all the recited features, or which provides any motivation to modify Wygodny et al. standing alone.

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.”<sup>26</sup> Further with regard to the level of skill of practitioners in the art, there is nothing in the statutes or the case law which makes “that which is within the capabilities of one skilled in the art” synonymous with obviousness.<sup>27</sup> The level of skill in the art cannot be relied upon to provide the suggestion to combine [or modify] references.<sup>28</sup>

As for the “inherency” of the features, as the Federal Circuit has held, “[t]o serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill.”<sup>29</sup> “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”<sup>30</sup>

Appellants submit that the Examiner has not met his burden of either establishing “well-known”, “inherent”, or “obviously inherent” features, with respect to the particulars of the invention recited in the claims on appeal.

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<sup>26</sup> See MPEP §2143.01, citing *In re Rouffet*, 149 F.3d, 1350, 1357, 47 USPQ2d 1453, 1457-8 (Fed. Cir. 1998).

<sup>27</sup> *Ex parte Gerlach and Woerner*, 212 USPQ 471 (PTO Bd. App. 1980).

<sup>28</sup> See MPEP §2143.01, citing *Al-Site Corp. v. VSI Int'l Inc.*, 50 USPQ2d 1161 (Fed. Cir. 1999).

<sup>29</sup> *Continental Can Co. v. Monsanto Co.*, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991).

<sup>30</sup> *In re Robertson*, 169 F.3d 743, 745, 49 USPQ 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

**SUMMARY**

In view of the arguments advanced above and in the Substitute Appellants' Brief, reversal of the Examiner's rejections and allowance of each of claims 1-37 are respectfully requested.

Dated: July 28, 2003  
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Respectfully submitted,

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